

IN THE CLAIMS: ✓

Please cancel claims 17 and 18 without prejudice or disclaimer of the subject matter thereof.

REMARKS

By the above amendment, the status of the parent application has been updated, such that the objection to the disclosure should now be overcome. Additionally, claims 17 and 18 have been canceled without prejudice or disclaimer of the subject matter thereof.

The rejection of claims 6 and 9-16 under 35 U.S.C. §102(b) as being anticipated by Ide et al (U.S. Patent 5,513,165) and the rejection of claims 7 and 8 under 35 U.S.C. §103(a) as being unpatentable over Ide et al (U.S. Patent 5,513,165), such rejections are traversed, and reconsideration and withdrawal of the rejections are respectfully requested.

At the outset, as to the requirements to support a rejection under 35 U.S.C. §102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may

anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

With respect to the requirements to support a rejection under 35 U.S.C. §103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under §103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to

deprecate the claimed invention.

Further, with regard to the requirements to support a rejection under 35 U.S.C. §103, reference is made to a recent decision decided by the U.S. Court of Appeals for the Federal Circuit on January 18, 2002, In re Lee, (Fed. Cir. 00-1158, 1/18/02) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge". The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

Turning to the rejection as set forth by the Examiner, assuming arguendo that features (a)-(c) as indicated by the Examiner may be considered to be an inherent feature of the recording medium of Ide et al, applicants submit that features

(d) and (e) as referred to by the Examiner are not disclosed by Ide et al in the sense of 35 U.S.C. §102.

Turning to feature (d), the Examiner contends that Ide et al apparently provides "the zone stores a lookup table (Fig. 7; information of a recorded test pattern is a kind of look-up table which stored in zone)" (emphasis added) and that "the look-up table having information about edge shifting of at least one of a leading and trailing edge of at least one recording pulse (Fig. 7; the test pattern contains information about a pulse's edge and its locations)" (emphasis added).

Turning to Fig. 7 of Ide et al, as shown therein, the apparatus for writing a test pattern on the recording medium and detecting the reproduced signal of such test pattern. Reference is made to Fig. 1 of the drawings of this application, which shows the algorithm needed for effecting a test recording, wherein the apparatus as illustrated in Fig. 7 has a test pattern write command signal applied to a test pattern writer when the recoding medium is placed in the recording apparatus and a test pattern is written on the recording medium and the written test pattern is reproduced from the recording medium, such that a comparison of the recorded signal with the reproduced signal is effected and control is effected in accordance therewith. While the test pattern may possibly be considered to be written in a zone, applicants submit that Ide et al in the sense of 35 U.S.C.

§102 does not disclose the feature that "said zone stores a lookup table having information about edge shifting of at least one of a leading and trailing edge of at least one recording pulse" as recited in claim 6 and therewith the dependent claims. The Examiner's contention that the zone stores a lookup table having the information as recited is a feature not disclosed by Ide et al in the sense of 35 U.S.C. §102 and represents speculation on the part of the Examiner (see In re Robertson, supra) and also represents the principle of "obvious to try" which is not the standard of 35 U.S.C. §103 (see In re Fine, supra).

In accordance with the present invention, as described at page 15, lines 17-26 and the following pages, a first lookup table of  $T_{MF}$  for the leading edge is a list of values which are determined by combinations of a length ( $M_n$ ) of a mark being currently written and a length  $S(n-1)$  of the space precedent to the mark and which can be positive or negative with a second lookup table of  $T_{ML}$  for the trailing edge being a list of values which are determined by combinations of the length  $M(n)$  of a mark being currently written and a length  $S(n+1)$  of a space subsequent to the mark and which can be positive or negative. Cases 1-8 are described and as pointed out at page 18, lines 7-10 of the specification, the values included in the first and second lookup tables and information on selection of any of the cases 1-8 are determined by reading

information written in the information track of the control data zone on the recording medium. As further pointed out, since adapted waveform change is based on the lookup tables are divided into the cases 1-8 and any of the cases is selected, the present invention can advantageously cope with recording media having various characteristics and can record information always stably with good compatibility. As pointed out at page 18, line 17 to page 18, line 7, the lookup tables while being described as a two-dimensional table may also be a three-dimensional table. Moreover, as pointed out at page 30, last paragraph, information can be recorded on a recording medium independently of characteristics of the recording medium or on characteristics of the information storage apparatus, always with good compatibility and stability.

Applicants submit that Ide et al does not disclose the features of claim 6 and the dependent claims in the sense of 35 U.S.C. §102 and 35 U.S.C. §103, and particularly, fails to disclose or teach a recording medium as recited in claim 6 having a zone including said at least one track therein, wherein said zone stores a lookup table having information about edge shifting of at least one of leading and trailing edge of at least one recording pulse. Thus, applicants submit that claim 6 and its dependent claims 7-16 patentably distinguish over Ide et al in the sense of 35 U.S.C. §102 and 35 U.S.C. §103.

With respect to the dependent claims, applicants note that claims 9-16 recite particular features concerning the lookup table which are not disclosed by Ide et al in the sense of 35 U.S.C. §102, such that claims 9-16 further patentably distinguish over Ide et al and should be considered allowable thereover. As to claims 7 and 8, the Examiner recognizes that these features are not disclosed by Ide et al and at page 9 of the Office Action, suggest that since Applicant's recording medium is used in a conventional information recording system, it would have been obvious to one of ordinary skill in the art to apply such features thereto. Applicants submit that this position by the Examiner is the position rejected by the court in the decision of In re Lee, supra and applicants submit that claims 7 and 8 also patentably distinguish over the cited art in the sense of 35 U.S.C. §103, and should be considered allowable thereover.

In view of the above amendments and remarks, applicants submit claims 6-16, the only claims remaining in this application, patentably distinguish over the cited art and should now be in condition for allowance. Accordingly, issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this

paper, including extension of time fees, to Deposit Account  
No. 01-2135 (500.37445CX1) and please credit any excess fees  
to such deposit account.

Respectfully submitted,



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500.37445CX1  
S.N. 09/695,089

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE SPECIFICATION:**

Page 1, please amend the paragraph beginning at line 1 as follows:

**CROSS REFERENCE TO RELATED APPLICATION**

This is a continuation of U.S. application Serial No. 09/366,641, filed August 4, 1999, now U.S. Patent No. 6,160,784, the subject matter of which is incorporated by reference herein.

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